

REMARKS

Applicants note that the Examiner stated in the “Response to Arguments” section the “Applicants arguments with respect to claims 1, 16, 20, 41-43, 68-69, 83-84, 100-102, 114, 118, and 135-138 have been considered but are moot in view of the new ground(s) of rejection. Applicants further note that the Examiner has included his previous objections verbatim from the middle of page 5 to the top of page 8 regarding 1-138 under 35 U.S.C. § 103(a) as being unpatentable over Raven et al. in view of Franchi. This argument is in addition to his new arguments with respect to claims 1, 16, 20, 41-43, 68-69, 83-84, 100-102, 114, 118, and 135-138 as being unpatentable over Raven et al. in view of Sugiyama. Thus, the Examiner appears to be abandoning his previous argument regarding 1-138 under 35 U.S.C. § 103(a) as being unpatentable over Raven et al. in view of Franchi, since the Examiner has not mentioned any problems with the Applicants’ arguments. However, since the Examiner has not explicitly stated that his previous rejection has been overcome, Applicants have repeated their previous arguments with respect to Raven et al. in view of Franchi in Section 2 of this paper in order to ensure that this reply is fully responsive.

1. Claim Rejections – 35 U.S.C. § 103(a) - Claims 1-138

The Examiner rejected claims 1-138 under 35 U.S.C. § 103(a) as being unpatentable over Raven et al. in view of Sugiyama. The Applicants respectfully traverse this rejection. For the sake of brevity, the rejections of the independent claims are discussed in detail on the understanding that the dependent claims are also patentably distinct over the prior art, as they depend directly from their respective independent claims. Nevertheless, the dependent claims include additional features that, in combination with those of the independent claims, provide further, separate and independent bases for patentability.

The Examiner has admitted that Raven lacks disclosure for: (1) “integrating the systems interface display system into the gaming platform screen used to display the gaming information,” and (2) “integrating game-play and service systems into a single interface.” Applicants have clarified that the claimed invention recites:

a gaming interface incorporated within the display screen of the gaming platform, wherein the gaming interface enables a player to view a wagering game through the display screen and participate in the wagering game through the display screen;

a systems interface incorporated into the display screen of the gaming platform, wherein the systems interface displays non-gaming system information from a system network through the gaming platform to a casino player or employee via the gaming interface display screen of the gaming platform, and wherein the systems interface allows requests to be input into the system network from the systems interface through the gaming platform by a casino player or employee

wherein the systems interface utilizes the gaming platform to produce enhanced system request capabilities with enhanced graphics and animation for enabling interactions with the system network.

As the Examiner has noted, Raven lacks disclosure of these elements. Nevertheless, the Examiner has stated that the Sugiyama reference “provides a wagering game that teaches the display of the wagering game including a touch screen capability, wherein the user is allowed to view and participate in the wagering game through the display screen (col. 4, lines 55-63) and provides the gaming machine with the capacity to display multiple graphical images in the game animations, which results in enhanced and interactive graphics. (fig. 9)” The Examiner also states with reference to the cited art, “[i]nteraction with a gaming system, whether by keypad input or touch-screen, provides the same function to the overall system.”

However, closer examination reveals that the Sugiyama reference simply discloses the use of pay-lines on a touch-screen display, both generally and with respect to col. 4, lines 55-63, and Fig. 9. Thus, the Sugiyama reference merely discloses the use of a gaming interface on a display screen in its traditional implementation. Furthermore, the claimed invention specifically recites that the “systems interface utilizes the gaming platform to produce enhanced system request capabilities ... for enabling interactions with the system network.” The Examiner has generously demonstrated, albeit most likely unintentionally, with the above-cited sections that none the art of record teaches or suggests “systems interface utilizes the gaming platform to produce enhanced system request capabilities ... for enabling interactions with the system network.” In contrast, (1) the Raven reference teaches a known systems interface that does NOT utilize the gaming platform to produce enhanced system request capabilities for enabling interactions with the system network, and (2) the Sugiyama reference merely discloses the use of a gaming interface on a display screen in its traditional implementation.

Consequently, the Examiner has merely cited a known system interface in the Raven reference, and a known gaming interface in the Sugiyama reference. As a result, the Examiner has done nothing to teach or suggest all of the recited elements of the claimed invention, which include:

(1) a gaming interface incorporated within the display screen of the gaming platform, wherein the gaming interface enables a player to view a wagering game through the display screen and participate in the wagering game through the display screen;

(2) a systems interface incorporated into the display screen of the gaming platform, wherein the systems interface displays non-gaming system information from a system network through the gaming platform to a casino player or employee via the gaming interface display screen of the gaming platform; and

(3) the systems interface utiliz[ing] the gaming platform to produce enhanced system request capabilities with enhanced graphics and animation for enabling interactions with the system network.

Moreover, neither has the Examiner given any alternative reason why he is not simply using hindsight to reconstruct the claimed invention from the cited references, while using the claimed invention as a blueprint. This type of rational is still prohibited post KSR¹, as was explained by the Federal Circuit in *Aventis Pharma Deutschland GmbH V. Lupin Ltd.*² when it stated, “We must still be careful not to allow hindsight reconstruction of references to reach the claimed invention without any explanation as to how or why the references would be combined to produce the claimed invention.”³

Accordingly, the Raven and Sugiyama references do not teach, disclose or suggest the above recited elements of claims 1-138. Thus, Applicants submit that claims 1-138 overcome the 35 U.S.C. § 103(a) rejection.

¹ *KSR Int'l Co. v. Teleflex Inc.*, 82 USPQ2d 1385, 1395 (2007).

² 499 F.3d 1293 (Fed. Cir. 2007).

³ *Id.*

2. Claim Rejections – 35 U.S.C. § 103(a) - Claims 1-138

The Examiner rejected claims 1-138 under 35 U.S.C. § 103(a) as being unpatentable over Raven et al. in view of Franchi. The Applicants respectfully traverse this rejection. For the sake of brevity, the rejections of the independent claims are discussed in detail on the understanding that the dependent claims are also patentably distinct over the prior art, as they depend directly from their respective independent claims. Nevertheless, the dependent claims include additional features that, in combination with those of the independent claims, provide further, separate and independent bases for patentability.

The Examiner has admitted that Raven lacks disclosure for: (1) “integrating the systems interface display system into the gaming platform screen used to display the gaming information,” and (2) “integrating game-play and service systems into a single interface.” Applicants have clarified that the claimed invention recites:

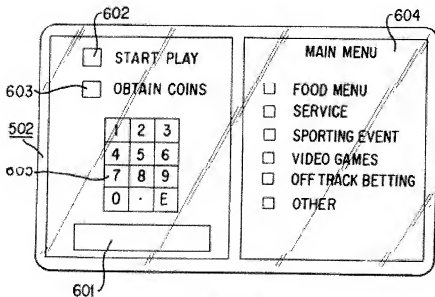
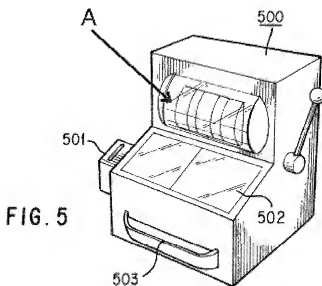
a gaming interface incorporated within the display screen of the gaming platform, wherein the gaming interface enables a player to view a wagering game through the display screen and participate in the wagering game through the display screen;

a systems interface incorporated into the display screen of the gaming platform, wherein the systems interface displays non-gaming system information from a system network through the gaming platform to a casino player or employee via the gaming interface display screen of the gaming platform, and wherein the systems interface allows requests to be input into the system network from the systems interface through the gaming platform by a casino player or employee.

Support for these amendments can, for example, be found on pg. 16, l. 23 to pg. 17, l. 13 of the specification as filed; Figure 5; and the preamble of claim 1. As the Examiner has noted, Raven lacks disclosure of these elements. Nevertheless, the Examiner has stated that Franchi provides a system that discloses a systems interface that is incorporated into the display screen of the gaming device. However, Applicants submit that Franchi suffers from the same shortcoming as Raven. The Franchi reference also discloses a player console that is separate and from the game presentation.

Specifically, amended claim 1 recites: “a gaming interface incorporated within the display screen of the gaming platform, wherein the **gaming interface enables a player to view a**

wagering game through the display screen and participate in the wagering game through the display screen” (emphasis added). Contrary to amended claim 1, the Franchi reference discloses a console 502 that does not allow a player to view a game being played (Figs. 5-6 of Franchi reproduced below).



According to Franchi, the game being played can only be viewed through the window marked with reference letter “A,” added for clarity. Since Franchi does not depict the game being played on the console 502, Franchi does not teach, disclose or suggest a “gaming interface [that] enables a player to view a wagering game through the display screen and participate in the wagering game through the display screen,” as recited in amended claim 1.

A fundamental difference between Franchi and the claimed invention is that the claimed invention uses a single display that allows the user to view and participate in the wagering game and to view a system interface, whereas Franchi uses window “A” to view the game being played and uses a separate console 502 to allow the user to participate in the game. A technical effect of the above technical difference is that the claimed device allows the user to look at and interact with only one display instead of having to look up and down between window “A” and console 502 which may cause the user to generally have an uncomfortable playing position and even eventually develop neck cramps/pain. Additionally, another technical difference is that since the claimed device enables the user to look at and have to interact with only one display, a player can dedicate his full attention to the gaming interface display screen, and not have to look up and down between window “A” and console 502 which may cause the user to lose track of his place in the game. Accordingly, we respectfully submit that the above feature of claim 1 provides for a device that is technically superior to the device of Franchi. Independent claims 16, 41, 42, 43, 68, 69, 83, 84, 100, 101, 102, 114, 135, and 136 each include the same carrying features as claim 1.

Similarly, for the reasons stated above for claim 1, Franchi does not teach, disclose or suggest “displaying the wagering game on the display screen,” as recited in amended claims 137 and 138. Therefore, amended claims 137 and 138 are also patentable over Franchi.

Additionally, Applicants further submit that Hirsch suffers from the same shortcoming as Raven, with respect to the lack of gaming interface and systems interface combined in the main display screen through which the game is played. Thus, Applicants submit that claims 1-138 overcome the 35 U.S.C. § 103(a) rejection.

3. Rebuttal of Examiner's Conclusions

The Examiner makes a conclusory statement that “integrating game-play and service systems is well-known.” It appears that the Examiner is paraphrasing the claimed elements of “*a gaming interface incorporated within the display screen of the gaming platform, wherein the gaming interface enables a player to view a wagering game through the display screen and participate in the wagering game through the display screen*” and “*a systems interface incorporated into the display screen of the gaming platform, wherein the systems interface displays non-gaming system information from a system network through the gaming platform to a casino player or employee via the gaming interface display screen of the gaming platform.*” Applicants submit that the Examiner has not provided any supporting references which teach or suggest that the above-claimed elements are well-known.

Applicants respectfully refer the Examiner to MPEP §2144.03B, which requires a technical line of reasoning when relying on “common knowledge.” More specifically, “there must be some form of evidence to support an assertion of common knowledge.” See *In re Zurko*, 258 F.3d 1379, 1386 (Fed. Cir. 2001) (holding that general conclusions concerning what is “basic knowledge” or “common sense” to one of ordinary skill in the art without specific factual findings and some concrete evidence in the record to support these findings will not support an obviousness rejection).

Continuing, the Examiner’s assertion that the above-claimed element was well known at the time the invention was made, is completely unsupported by the art of record. Accordingly, Applicants respectfully traverse this assertion by the Examiner and formally request that the Examiner provide reference(s) in support of this assertion. Otherwise, an Examiner cannot maintain a rejection based on his own opinion as to what is common knowledge and well known in an art without any supporting references, after the Applicants have challenged the Examiner’s assertion. MPEP. § 2144.03.

Specifically, none of cited references teach or suggest the claimed elements of (1) *a gaming interface incorporated within the display screen of the gaming platform, wherein the gaming interface enables a player to view a wagering game through the display screen and participate in the wagering game through the display screen*; and (2) *a systems interface [that*

is/ incorporated into the gaming interface display screen of the gaming platform, wherein the systems interface displays non-gaming system information from a system network through the gaming platform to a casino player or employee via the gaming interface display screen of the gaming platform” “wherein the systems interface utilizes the gaming platform to produce enhanced system request capabilities with enhanced graphics and animation for enabling interactions with the system network.” These capabilities are made possible by the unique abilities derived from the gaming platform used in conjunction with the systems interface. In the cited references, all of the identified systems interfaces (i.e., devices for interfacing with a system network to access “non-gaming” system-type functions) have not been incorporated into the gaming platform of a gaming device. As a result, these systems interfaces have not been able to produce (1) enhanced system request capabilities and (2) enhanced graphics and animation for enabling interactions with the system network. These are clear limitations of the cited references that have been overcome by the claimed invention.

The Examiner has relied on the Raven et al. reference and the Hirsch et al. reference. The Raven et al. reference discloses external system (non-gaming) components such as an external 2-line VF display and an external keypad shown with limited capabilities due, at least in part, to their separation from the gaming platform. This limitation is overcome by the architecture of the claimed invention. The Hirsch reference is cited by the Examiner for disclosing the capacity to display multiple graphical images in the game animations. Respectfully, it appears that the Examiner may be overlooking the claimed capability to produce (1) enhanced system (non-gaming) request capabilities and (2) enhanced graphics and animation for enabling interactions with the system (non-gaming) network.

The Examiner has taken the position that it would be obvious to integrate gaming and system services into a single display system. The Examiner has cited MPEP § 2144.04 as well as the case of *In re Larson*, 340 F.2d 965, 968; 144 USPQ 347, 349 (CCPA 1965), in support of this “obvious to integrate” position.

MPEP § 2144.04 Does Not Allow The Use Of Case Law To Support An Obviousness Rejection Once The Criticality Of A Specific Limitation Has Been Demonstrated

Applicants respectfully point out MPEP 2144.04 Legal Precedent as Source of Supporting Rationale, which states: “As discussed in MPEP § 2144, if the facts in a prior legal

decision are sufficiently similar to those in an application under examination, the examiner may use the rationale used by the court. ... If the applicant has demonstrated the criticality of a specific limitation, it would not be appropriate to rely solely on case law as the rationale to support an obviousness rejection.” (emphasis added).

Therefore, once the Applicants have demonstrated the criticality of a specific limitation, it is no longer permissible for an Examiner to rely solely on examples in case law (which are listed in MPEP § 2144.04) to support an obviousness rejection. Accordingly, since the Applicants have explained how the claim limitation of the systems interface utilizing the gaming platform to produce “*enhanced system request capabilities with enhanced graphics and animation for enabling interactions with the system network*,” the Examiner can no longer rely on *In re Larson*, as sole support for his “obvious to integrate” position.

Accordingly, Applicants respectfully submit that MPEP § 2144.04 supports the Applicants’ position, and that the 35 U.S.C. § 103(a) rejection of claims 1-138 as unpatentable over *Raven et al.* has been overcome.

The Facts Of *Schenck V. Nortron Corp.*, In Which The Court Found The Claims To Be Patentable, Are More Analogous To The Current Situation Than The Facts Of *In re Larson*

Referring now to MPEP § 2144.04 (V)(B), in the case of *Schenck v. Nortron Corp.*, 713 F.2d 782, 218 USPQ 698 (Fed. Cir. 1983), the claims were directed to a vibratory testing machine (a hard-bearing wheel balancer). The vibratory testing machine included a holding structure, a base structure, and a supporting means that form “a single integral and gapless continuous piece.” The opponent of the patentee argued that the patentee’s invention just made integral what had been previously made in four bolted pieces. However, the court found this argument unpersuasive and held that the claims were patentable because the prior art perceived a need for mechanisms to dampen resonance. The inventor eliminated the need for dampening via the one-piece gapless support structure, showing insight that was contrary to the understandings and expectations of the art.

As such, Applicants posit that *Schenck v. Nortron Corp.* is far more relevant than *In re Larson*, in which “a brake drum integral with clamping means” was found not to be patentably distinct from the prior art, where a brake disc and clamp were comprised of several parts but

rigidly secured together as a single unit. In the case of *In re Larson*, there was no perceived benefit of rigidly securing several parts into a single unit; and thus, there was no patentably distinct invention. However, in *Schenck v. Nortron Corp.*, there was a benefit to combining the supporting means into “a single integral and gapless continuous piece.” That benefit was the elimination of the need for a dampening system. In the claimed invention of the present application, the incorporation of a systems interface into the display screen of the gaming platform, and the utilization of the gaming platform by the systems interface, results in the benefits of (1) enhanced system request capabilities and (2) enhanced graphics and animation for enabling interactions with the system network. Therefore, the claimed invention of the present application clearly shows a distinct benefit, as did the claimed invention in *Schenck v. Nortron Corp.*, and thus, the claimed invention of the present application is patentability distinct over the prior art.

Accordingly, Applicants respectfully submit that MPEP § 2144.04 (V)(B) supports the Applicants’ position, and that the 35 U.S.C. § 103(a) rejection of claims 1-138 as unpatentable over Raven et al. has been overcome.

According to MPEP § 2144.04 (II)(B), Omission of an Element with Retention of the Element’s Function Is an Indicia of Unobviousness

Applicants note that MPEP § 2144.04 (II)(B) clearly states that the omission of an element and retention of its function is an indicia of unobviousness. Referring now to MPEP § 2144.04 (II)(B), in the case of *In re Edge*, 359 F.2d 896, 149 USPQ 556 (CCPA 1966), the claims at issue were directed to a printed sheet having a thin layer of erasable metal bonded directly to the sheet. The thin layer obscured the original print until it was removed by erasure. The prior art disclosed a similar printed sheet that also included an intermediate transparent layer and erasure-proof protecting layer that prevented erasure of the printing when the top layer was erased. The claims were found to be unobvious over the prior art because (1) the transparent layer in the prior art was eliminated, and (2) the function of the transparent layer was retained (since appellant’s metal layer could be erased without erasing the printed indicia).

Analogously, in the claimed invention of the present application, external system components (such as an external 2-line VF display and an external keypad shown in the Raven et al. reference) have been eliminated, while their functions have been retained. Indeed, as

discussed in Section 2 above, not only have their functions been retained, their functions have been enhanced. Using the claimed invention, the system network is able to send system information, in an enhanced format, to a player or employee through the gaming platform to the systems interface, which is in the display screen of the gaming device itself. As a result, the need for the external 2-line VF display has been eliminated, while associated functionality has not only been maintained, it has actually been enhanced. In a similar manner, incorporating the systems interface (1) into the display screen and (2) through the gaming platform has eliminated the need for the external keypad, while its associated functionality has not only been maintained, it has actually been enhanced.

Accordingly, Applicants respectfully submit that MPEP § 2144.04 (II)(B) supports the Applicants' position, and that the 35 U.S.C. § 103(a) rejection of claims 1-138 as unpatentable over Raven et al. has been overcome.

The Examiner has impermissibly used hindsight to render the invention obvious. It is a well-settled principle that "one cannot use hindsight to construction to pick and choose among isolated disclosures to deprecate the claimed invention." *In re Fritch*, 23 USPQ2d 1780, 1784 (Fed. Cir. 1992). The Applicant respectfully submits that the Examiner has impermissibly used hindsight to render the present invention obvious. Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability—the essence of hindsight. *In re Dembiczak*, 175 F.3d 994, 999 (CAFC 1999). The range of sources available, however, does not diminish the requirement for actual evidence. That is, the showing must be clear and particular. See, e.g., *C.R. Bard*, 157 F.3d 1340, 1352, 48 USPQ2d. 1225, 1232 (Fed. Cir. 1998). "Broad conclusory statements regarding the teachings of multiple references, standing alone, are not 'evidence'" (emphasis added). *In re Dembiczak*, 175 F.3d at 999.

Therefore, Applicant respectfully submits that the 35 U.S.C. §103(a) rejection of claims 1-138 have been overcome.

CONCLUSION

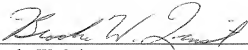
Applicants have made an earnest and *bona fide* effort to clarify the issues before the Examiner and to place this case in condition for allowance. Reconsideration and allowance of all of claims 1-138 is believed to be in order, and a timely Notice of Allowance to this effect is respectfully requested.

The Commissioner is hereby authorized to charge the fees indicated in the Fee Transmittal, any additional fee(s) or underpayment of fee(s) under 37 CFR 1.16 and 1.17, or to credit any overpayments, to Deposit Account No. 194293, Deposit Account Name STEPTOE & JOHNSON LLP.

Should the Examiner have any questions concerning the foregoing, the Examiner is invited to telephone the undersigned attorney at (310) 734-3200. The undersigned attorney can normally be reached Monday through Friday from about 9:00 AM to 6:00 PM Pacific Time.

Respectfully submitted,

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